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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 2038-310									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 10/730,260	Filed December 9, 2003								
		First Named Inventor Toshifumi OTSUBO									
		Art Unit 3761	Examiner Melanie Jo Hand								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"> <tr> <td><input type="checkbox"/> applicant/inventor.</td> <td><u>/Benjamin J. Hauptman/</u></td> </tr> <tr> <td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td> <td><u>Benjamin J. Hauptman</u> Signature Typed or printed name</td> </tr> <tr> <td><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,310</u></td> <td><u>703-684-1111</u> Telephone number</td> </tr> <tr> <td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td> <td><u>May 16, 2007</u> Date</td> </tr> </table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>				<input type="checkbox"/> applicant/inventor.	<u>/Benjamin J. Hauptman/</u>	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Benjamin J. Hauptman</u> Signature Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,310</u>	<u>703-684-1111</u> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>May 16, 2007</u> Date
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<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>May 16, 2007</u> Date										

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No.: 2038-310

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	:	EXPEDITED PROCEDURE
Toshifumi OTSUBO	:	:	Response under 37 CFR 1.116
	:	:	
Serial No. 10/730,260	:	:	Group Art Unit: 3761
	:	:	
Filed: December 9, 2003	:	:	Examiner: Melanie Jo Hand
	:	:	

For: PANTS-TYPE DISPOSABLE WEARING ARTICLE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria VA 22313-1450

Sir:

This paper is submitted in reply to the Final Office Action mailed February 16, 2007.

Applicants respectfully request review of the final rejections of claims 1-20 as manifested in the Final Office Action. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal in compliance with 37 CFR 41.31 and the fee set forth in 37 CFR 41.20(b)(1).

The review is requested for the reasons stated on the attached sheets.

REASONS

The following clear errors are found in the Examiner's rejections.

1. With respect to independent claim 1, the final rejection is clearly erroneous, because the art fails to teach or suggest the feature of claim 1 that

“a plurality of auxiliary elastic members secured to said chassis in a stretched state and extending in said waist surrounding direction so as to cross said absorbent structure in at least one of said front and rear waist regions,

each of said auxiliary elastic members having, in said waist surrounding direction, opposite end portions and a middle portion located between said opposite end portions,

said opposite end portions being secured to said chassis in vicinities of transversely opposite side edges of the one of said front and rear waist regions while said middle portion being free of direct securement to said chassis in the one of said front and rear waist regions.”

Olson fails to teach or suggest the claimed feature as admitted by the Examiner.¹ None of the other cited references teach or suggest the claimed feature.

In particular, the Examiner is relying on U.S. Patent No. 6,478,785 to *Ashton*² for “balloon pants.” Since the Examiner has not specified the specific portion of *Ashton* being relied upon, Applicants have carefully reviewed the whole reference and found the only relevant “balloon pants” teaching at column 1 lines 27-43. This teaching, however, does not disclose or suggest the above discussed claimed feature, because it is completely silent on how the *Ashton* elastic elements are attached to the diaper/pants body.

In addition, the Examiner's interpretation of *Ashton*'s teaching that “elastic elements are secured to the waist opening in a contracted state and thus create zones where the material is contracted while the remaining material blouses”³ along with the *Olson* teachings as encompassing the claimed feature is incorrect. The relevant teachings of *Ashton*, especially U.S. Patent No.

¹ See Final Office Action at page 4, line 9 from bottom.

² See Final Office Action at page 2, lines 10-15.

³ See Final Office Action at page 2, lines 12-15.

5,171,239 and U.S. Patent No. 4,610,681 cited by *Ashton*⁴ as examples of “balloon pants,” make it clear to a person of ordinary skill in the art that in “balloon pants,” the waist and leg elastics contract and cause the central portions of the waist regions to blouse. This is evident from Figs. 1 of both US patents 5,171,239 and 4,610,681. The *Ashton* reference, in the section apparently relied on by the Examiner, does not teach or suggest the manner in which the elastic elements are attached to the diaper/pants body, and hence, would not have motivated the person of ordinary skill in the art to have modified *Olson* to arrive at the claimed invention.

The other cited references, i.e., U.S. Patent No. 6,746,436 to *Sierra* and U.S. Patent Application Publication No. 2001/0047160 to *Klemp*, also fail to teach or suggest the claimed feature. Since the Examiner has, again, failed to specify the specific portions of *Sierra* and *Klemp* being relied upon, Applicants have independently reviewed the references and do not find any teaching or suggestion of the claimed feature, i.e., the middle portions of the auxiliary elastic members being free of direct securement to the chassis. The fact that the art might have disclosed wearing articles with elastic strands in some regions and without elastic strands in other regions is neither indicative nor suggestive of how the elastic strands are bonded to the article.

Accordingly, Applicants respectfully submit that the rejection of independent claim 1 is clearly erroneous and should be withdrawn. The rejection of dependent claims 2-4 and 6-20 should be withdrawn for at least the same reason.

2. With respect to independent claim 5, the final rejection is clearly erroneous, because the art fails to teach or suggest the feature of claim 5 that

“a length of said auxiliary elastic members in the waist-surrounding direction as measured in a contracted state thereof is generally equal to a corresponding length of the absorbent structure in the one of said front and rear waist regions.”

The rejection of claim 5 is erroneous for at least the reason advanced in the November 28, 2006 Response⁵ which is incorporated by reference herein.

⁴ See *Ashton* at column 1 lines 33-34.

⁵ See November 28, 2006 Response at page 3, lines 11-23.

Serial No. «Serial_Number»

The Examiner's response ⁶ to Applicants' argument is noted. In particular, the Examiner is relying on element 80 in Fig. 3 of *Olson* for the claimed auxiliary elastic members. It should be noted that *Olson*'s element 80 is not elastic element, rather it is only a simulated elastic band.⁷ The simulated elastic band 80 is part of the outer cover graphics which are generally referred to by *Olson* as appearance-related components which, in turn, are to simulate functional components such as elastic waist and leg bands.⁸ Thus, *Olson* does not teach or suggest that simulated elastic band 80 actually includes elastic elements. Even if simulated elastic band 80 does include elastic elements, there is no disclosure or suggestion that such elastic elements meet the claimed length requirement.

Accordingly, Applicants respectfully submit that the rejection of independent claim 5 is clearly erroneous and should be withdrawn.

3. With respect to dependent claims 6 and 11-20, the final rejections of these claims are clearly erroneous for at least the reasons advanced in the November 28, 2006 Response ⁹ which are incorporated by reference herein.

The Examiner has failed to respond to Applicants' arguments regarding claims 6, 11-18 and 20.

The Examiner's response ¹⁰ to Applicants' argument regarding claim 19 is noted. It appears that the Examiner is still relying on Fig. 1 of *Olson* ¹¹ as showing the claimed "auxiliary elastic members are disposed between and spaced in the longitudinal direction from said elasticized waist hole and said elasticized leg holes." Applicants respectfully submit that Fig. 1 of *Olson* does not teach or suggest any elastic members. The elements 80, 82, 84, which appear to be elastic members, are actually not elastic members. They are only simulated elastic members, i.e., graphics,

⁶ See Final Office Action at the paragraph bridging pages 2-3.

⁷ See *Olson* at column 13 lines 23-26.

⁸ See *Olson* at the paragraph bridging columns 12-13.

⁹ See November 28, 2006 Response at pages 4-5.

¹⁰ See Final Office Action at page 3, the first full paragraph.

¹¹ See Final Office Action at page 7, the last full paragraph.

Serial No. «Serial_Number»

as detailed above with respect to claim 5.¹² The elements disclosed in Fig. 1 of *Olson* do not exhibit elastic behavior, contrary to the Examiner's argument.¹³

It should be now apparent to a person of ordinary skill in the art that *Olson* and the knowledge generally available in the art fail to teach or suggest (i) auxiliary elastic members having middle portions being free of direct securement to the chassis, as recited in claim 1, and (ii) such auxiliary elastic members being disposed between and spaced in the longitudinal direction from said elasticized waist hole and said elasticized leg holes, as recited in claim 19. Accordingly, Applicants respectfully submit that the rejection of claim 19 is clearly erroneous and should be withdrawn.

Although not reviewable by a pre-appeal brief review panel, the following issues are also clear errors found in the Examiner's action. First, by citing the new references, such as *Ashton*, *Sierri* and *Klemp*,¹⁴ the Examiner has effectively and substantively modified the rejections so as to be new rejections. Therefore, the finality of the current action is improper. Second, the Examiner has failed to provide a PTO-892 form indicating that the additional references have been considered.

¹² See also *Olson* at column 13 lines 23-26.

¹³ See Final Office Action at page 3, the last sentence of the first full paragraph.

¹⁴ See Final Office Action at page 2, lines 11-17.

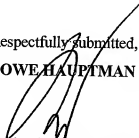
Serial No. «Serial_Number»

Withdrawal of the final rejections of claims 1-20 in view of the above is believed appropriate and therefore respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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